REMARKS

Claims 1-22 are pending in the application.

Claims 1-3 have been rejected.

Claims 4-6 have been objected to as depending from rejected claims.

Claims 7-22 have been allowed.

Reconsideration of the Claims is respectfully requested.

1. Rejection under Section 102/103

Claims 1-3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,184,660 to Hatular ("Hatular").

For establishing anticipation, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim." MPEP 2131 at p. 2100-67 (Rev. 5, August 2006) (citations omitted).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142, p. 2100-125 (Rev. 5, August 2006) (citations omitted).

A Section 102/103 rejection may be applied on an inherency basis, in that "[w]here applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. . . . This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic." MPEP § 2112, p. 2100-47 (Rev. 5, August 2006) (citations omitted). In this regard, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the

applied prior art." *Id.* at p. 2100-48. Applicant respectfully submits that Hatular does not include inherent characteristics that necessarily flow from its teachings that apply towards its claimed invention as recited in Claims 1 through 3.

Hatular relates to a "system . . . for use in battery powered portable devices that is identified as the System Management Bus ("SMBus"). . . . The SMBus specification envisions the SMBus interconnecting at least a system host computer, a smart battery charger, and a smart battery . . . ." (Hatular 1:17-26). The object of Hatular is "to provide an improved, high efficiency battery charger IC that senses charging current." (Hatular 3:57-59).

In Hatular, the Smart Management Bus (SMB) device includes a "SMB interface and charging control 122 may transmit an ALRT signal, i.e. an interrupt, to other devices connected to the SMBus 32 via a SMBALRT line 124 included in the SMBus 32. . . . Responsive to the clock signal present on the SMBC line 126, the SMB interface and charging control 122 exchanges data with other devices connected to the SMBus 32, e.g. the host computer 26 or the smart battery 22, via a SMBD line 128. Such inter-device communications may selectively cause data to be written into and/or read from a set nine (9) registers included in an interface register block 132 of the SMB interface and charging control 122." (Hatular 8:22-40).

Hatular recites that "the battery charger IC 50 ceases operation immediately when the AC adaptor 42 becomes disconnected from the external source of electrical power." (Hatular 5:65-67 – 6:1-2). Hatular, however, does not recite "*a control unit* to switch the converter to a battery-charge mode of operation to power the integrated circuit *and* to charge the battery, when external power is supplied."

The "switches 62" of Hatular, as understood, do not function as a control unit, but instead are for controlling its "PWM buck converter circuit 60 [of the battery charger 50]." In Hatular, the "switch drive 162 receives from a pulse-width-modulation ("PWM") circuit 182 included in the battery charger IC 50 a charger control signal which establishes a time interval during which the series switch 62 will be turned-on if the synchronous-rectifier switch 76 is turned-off, and during which the synchronous-rectifier switch 76 will be turned-on if the series switch 62 is turned-off." (Hatular 12:46-52).

Also, the Office Action submits that it "would have been obvious to . . . have integrated the components [of Applicant's claimed invention] into a single component," citing *In re Fridolph*,

309 F.2d 509, 50 CCPA 745 (1962) (Office Action at pp. 3-4). In *Fridolph*, the "object of the invention is to provide a simple and cheaply constructed device which . . . will possess sufficient strength to hold heavy portieres and still be sufficiently inconspicuous to support light curtains as well." *Id.* at 511-12. Applicant respectfully submits that the proposition of the case does not appear to lend itself to support rejection of the instant claimed invention.

As explained in Applicant's Specification at page 9, the "control unit 203, which may be in the form of hardware, software, or a combination of both, controls the value of the voltage or current being sourced from voltage source 223 or current source 222. . . . Thus, with the external power coupled to circuit 200, the battery is not used to generate V_{OUT}. Control unit 203 also monitors the presence of the external power, so that if external power is not present, the battery powers the DC-DC converter 201 in the battery-operated mode. As noted, control line 212 from the control unit 203 controls switch 225 to place either the current source 222 or the voltage source 223 into the circuit, when external power is present." (Specification at page 9, *ll.* 26-31 through page 10, *ll.* 1-4).

In kind, Applicant's Independent Claim 1 recites, *inter alia*, an "apparatus comprising: a converter within an integrated circuit to convert a battery voltage from a battery to an output voltage to power the integrated circuit in a battery-operated mode of operation, when the battery is made available to the integrated circuit; and *a control unit* to switch the converter to a battery-charge mode of operation to power the integrated circuit *and* to charge the battery, when external power is supplied." (emphasis added).

Accordingly, Applicant respectfully submits that a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of Hatular.

2. Allowable Subject Matter

Applicant notes with appreciation the indication of allowability of Claims 4-6, which would be allowable if rewritten in independent form.

Applicant further notes with appreciation the allowance of Claims 7-22.

3. Conclusion

As a result of the foregoing, the Applicant respectfully submits that, in addition to Claims 7-22, Claims 1-6 in the Application are also in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ksmith@texaspatents.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 50-2126.

Respectfully submitted,

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